REMARKS

Applicant hereby replies to the Final Office Action of January 22, 2009, in the above-referenced patent application. Applicant thanks the Examiner for carefully considering the application.

Status of Claims

After this amendment, claims 20-37 are currently pending. Claims 20, 28 and 32 are independent.

Claims 20-34 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,758,257 ("Herz").

Claim Amendments

Claims 20, 28 and 32 are amended. New claims 35-37 are added. Applicant notes that support for the amended and new limitations is given in at least paragraphs [3255], [3256], [3263] – [3268] of the published application. No new matter has been added.

Rejection under 35 U.S.C. §102(b)

Rejection of claims 20-34 is respectfully traversed because, for at least the following reasons, Herz fails to show or suggest all of the claimed limitations.

According to MPEP §2131,

'[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

The claimed invention is directed to a system and method for personalizing TV. Independent claim 20 requires, in part, "presenting the viewer with *a first list of TV programs* available for viewing, the programs selected and arranged in accordance with the viewer characteristics information profile; *receiving feedback input from the viewer after viewing the first list, the input requesting different selections than in the first list*; and presenting the viewer with *a second list including alternative TV programs available for viewing*, the alternative programs selected in accordance with an alternative viewer characteristics information profile, wherein *the feedback is based on the viewer answering a query*" (emphasis added). Independent claim 28 requires, in part, "presenting the viewer with one of *a first list of the selected programs and an alternative second list of programs*, the first list arranged in accordance with the viewer characteristics information profile, and the second list arranged in accordance with an alternate viewer characteristics information profile, wherein *the second list is based on feedback input from the viewer of the first list resulting from a query*" (emphasis added). Independent claim 32 requires, in part, "presenting the viewer with a first list of the selected programs, the first list arranged without viewer input in accordance with the viewer characteristics information profile; *receiving feedback input from the viewer based on a query about the first list*; and *presenting the*

viewer with a second list of selected programs based on said feedback input" (emphasis added).

Herz fails to disclose or suggest at least the above-mentioned limitations.

Herz discloses that customer profiles are updated based on whether a show that was predicted to be watched by a viewer was not watched (Herz, col. 26, line 64-col. 27, line 1). The updating of the profile is done by use of passive monitoring (Herz, col. 26, line57-60). Based on the passive monitoring, if the profile of the user is modified, a program viewing list in Herz is modified to create a new replacement list. Therefore, the "feedback" from a user in Herz must be input based on the passive monitoring by a viewer. Thus, the viewer does not enter feedback input after the viewer views a first list as the viewer in Herz simply watches a show or does not watch a show. Further, as passive monitoring is used in Herz, the viewer is not requesting anything. In contrast, the feedback in Applicant's claimed invention *"is based on the viewer answering a query"* (emphasis added). This is clearly distinguishable from passive monitoring as with Herz. Applicant notes that support for the amended limitations can be viewed in at least paragraphs [3255], [3256], [3263] – [3268] of the published application.

Moreover, after a viewer views the programming list, Herz does not request input in the form of a query from the viewer. In Herz, since the first list is updated or modified to form the second list, the first and second lists are not available at the same time. This leads one to believe that there is really only one available list in Herz, which is different from the existence of alternative lists.

Therefore, since Herz does not teach, disclose or suggest all of Applicant's claims 20, 28

and 32 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C.

§102(b) has not been adequately set forth relative to Herz. Thus, Applicant's amended claims

20, 28 and 32 are not anticipated by Herz. Additionally, the claims that directly or indirectly

depend on claims 20 and 28, namely claims 21-27, and 29-34, respectively, are also not

anticipated by Herz for the same reason.

Accordingly, withdrawal of the rejection of claims 20-34 is respectfully requested.

Applicant's new claim 35 requires, in part, that *"the first list remains available after*

presenting the second list" (emphasis added). In Herz, however, the second list is a modification

of the first list. Since the "second" list in Herz is a modified first list, once the first list is

modified based on updating the user profile, the first list no longer exists. Therefore, Herz

cannot teach that the first list remains available after presenting the second list. Therefore, since

Herz does not teach, disclose or suggest the limitations in new claim 35, new claim 35 could not

be found anticipated by Herz.

Applicant's new claim 36 requires, in part, that *"the second list is unrelated to the first*

list" (emphasis added). In Herz, however, the "second" list is simply a modified first list.

Therefore, since the second list in Herz is based off of the first list, Herz cannot teach *"the*

second list is unrelated to the first list" (emphasis added) as required, in part, by new claim 36.

Therefore, since Herz does not teach, disclose or suggest the limitations in new claim 36, new

claim 36 could not be found anticipated by Herz.

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Applicant's new claim 37 requires, in part, "*the second list is based on a viewer choice between alternative available lists*" (emphasis added). In Herz, the "second" list is based on modifying the first list after viewing a program. The "second" list or modified first list in Herz is presented to Herz based on the programs viewed. A viewer in Herz is not offered a choice in the matter of viewing lists. Therefore, Herz does not teach "*the second list is based on a viewer choice between alternative available lists*" (emphasis added) as required, in part, by new claim 37. Therefore, since Herz does not teach, disclose or suggest the limitations in new claim 37, new claim 37 could not be found anticipated by Herz.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests that the rejections of

the claims be withdrawn, and that the case be passed to issue. If the Examiner feels that a

telephone interview would be helpful to the further prosecution of this case, Applicant

respectfully requests that the undersigned attorney be contacted at the listed telephone number.

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Respectfully submitted,

Myers Andras Sherman LLP

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